## REMARKS/ARGUMENTS

Claims 1-4, 7-14, 17-25, 27 and 28 are pending in this application. Claims 1, 12 and 24 have been amended. Therefore, upon entry of this amendment, which is respectfully requested, claims 1-4, 7-14, 17-25, 27 and 28 will remain pending.

**The Presently Claimed Invention**

The presently claimed invention is directed to methods, in a messaging server, of connecting parties with mutual interests. A media object, such as, for example, a news story or link, is presented to a first user or a plurality of users as the users view web pages, for example. If a user opts to start a conversation about a specific media object the user is viewing, the user (a "conversation starter") provides a comment, for example by entering a comment on a comment page. The comment is preferably intended to spark an interest in other users. The comment is received by the server and then presented to other users along with the media object. For example, the comment, or a link to the comment is presented along side a news headline or other media object on the users' displays. A second user who may desire to join in a conversation about the media object with the conversation starter views the first user's comment and responds with a reply comment, which is then sent to the conversation starter (first user). The conversation starter receives and reviews the comment. The first user may not reply to the comment, so no messaging session is established, however, if the comment is subjectively acceptable, the conversation starter may indicate approval of the reply comment. Responsive to the indication of approval, or other matching criteria, the responding user and conversation starter are then connected in a messaging session, such as an instant messaging session. If the first user does not indicate approval, a messaging session may not be started by the server. Multiple users may be connected in a single messaging session by the conversation starter in this manner. The techniques of the present invention advantageously allow an individual who starts a messaging session (*e.g.*, conversation) to maintain full control over who is able to join that conversation as well as how many are able to join at any one time.

**Rejections**

Claims 1-29[1] were rejected under 35 USC §112, first paragraph, because the specification "does not reasonably provide enablement for connect [sic] to instant messaging server."

Claims 1-28[2] were also rejected under 35 USC §112, first paragraph, as failing to comply with the enablement requirement. In particular, it was stated that "[i]t was unclear How [sic] a first and second user who were not connected to the session could receive a comment?" It was also stated that "[i]t also unable to a skill in the art to perform an undue experiment for established communication between the first and second user via a messaging server wherein the first user and the second user were not connected to the messaging session."

These enablement rejections are respectfully traversed for at least the following reasons. The specification does indeed teach that the first and second users are not in an instant messaging session prior to receipt of a reply comment. The Examiner is referred to the specification at page 5, lines 22 to page 7, line 32 as an example of support for such teaching. As discussed therein, users view web pages and are presented with media objects. There is no active messaging session at this point. A user who decides to start or join a conversation about a media object may do so, e.g., by selecting an indicator to start or join a conversation (e.g., selectable indicator 210 of Figure 3). The user may start a conversation and submit a comment about the media object, or the user may view comment(s) already submitted regarding a media object. Thus, the specification teaches providing a media object to be displayed to a first user, receiving a first comment from the first user and providing the media object to be displayed to a second user along with the first comment. All this is done outside of a chat system or messaging session, e.g., with the users viewing web pages with comments (e.g., static web pages). With reference to the specification at page 7, lines 17-24, a user may submit a reply comment, e.g., via a response page. If the reply comment fits a matching criteria (e.g., approved by the first user - the user that posted the initial comment), the users are then connected in a messaging session by

[1] It is assumed that the Examiner intended to reject only the pending claims, claims 1-4, 7-14, 17-25, 27 and 28.
[2] Again, it is assumed that the Examiner intended to reject only the pending claims, claims 1-4, 7-14, 17-25, 27 and 28. Additionally, it is not clear how this enablement rejection differs from the first enablement rejection. Thus, the response will respond as if there were a single enablement rejection.

messaging server 20 (see, e.g., page 7, lines 28 to 32). Accordingly, both the specification, and the claims are enabled.

Claims 1-28[3] were rejected under the judicially created doctrine of double patenting over claims 1-23 of US Patent No. 6,651,086. The Examiner provides a comparison between the pending claims and the claims of US Patent No. 6,651,086. However, it is noted that the pending claims as listed do not reflect the actual claims as currently pending prior to this Office Action. For example, claim 1 as recited in the Office Action does not correspond to claim 1 as filed in the Preliminary Amendment accompanying the filing of the present application. The pending claims as filed with the Preliminary Amendment are also reproduced herein. It is respectfully requested that the Examiner analyze this rejection in view of the actual pending claims presented in the Preliminary Amendment. Should the Examiner nonetheless maintain this rejection after such analysis, Applicants will then consider the merits of the rejection and also whether a terminal disclaimer should be filed.

Claims 1-4, 7-14, 17-25, 27 and 28 were rejected under 35 USC §103 as being unpatentable over Barrett *et al.*, US Patent No. 6,400,381 (hereinafter "Barrett") in view of Okada *et al.*, US Patent No. 6,363,461 (hereinafter "Okada"). This rejection is respectfully traversed for at least the following reasons.

Okada discloses a communication management system for use with a chat system where multiple users communicate over various communication channels in a network. The communication management system of Okada is adapted to recognize a log file produced for a predetermined channel of the chat system during a chat session between clients. The management system is also adapted to transmit a log file or a portion of a log file to an external communication device not associated with the chat system, for example, for use by a user when not connected to or participating in a chat. A log file as disclosed in Okada is a record of communications (*e.g.*, time, user ID and text) occurring during a chat session between a plurality of clients. See, *e.g.*, Okada, Figures 6-12 and 16-17. The portion of a log file transmitted to the external device is determined based on various criteria or previously stored conditions input by a

[3] Again, it is assumed that the Examiner intended to reject only the pending claims, claims 1-4, 7-14, 17-25, 27 and 28.

user, for example, a log file of a chat session involving a specific username, or occurring during a specific time period, or including a specific character string. See, *e.g.*, Okada, column 11, lines 14-65, column 12, lines 56-65, and column 13, line 47 to column 14, line 3. Upon receiving and viewing a log file at an external communication device, the user may wish to join in a chat session in the chat system by returning to a client workstation and joining in. See, *e.g.*, Okada, column 13, line 61 to column 14, line 3, and column 15, line 59 to column 16, line 29. Okada also discloses automatically sending a predetermined message on behalf of a user to a channel of a chat system when the user has not transmitted a message to the channel after a predetermined time period. See, *e.g.*, Okada, column 18, line 44 to column 19, line 40.

Barrett discloses a system and method for creating a communication group in accordance with the historical activity of users in accessing the same or similar document.

Applicants respectfully assert that Okada and Barrett, either taken alone or in combination as suggested in the Office Action, neither teach nor suggest the limitations of the presently claimed invention. For example, both Barrett and Okada fail to teach or suggest the limitations of receiving a first comment from the first user or providing the media object to be displayed to a second user along with the first comment as recited in claim 1. Similar limitations are presented in independent claims 12 and 24. To the contrary, Barrett teaches receiving a comment as part of a chat session and providing a media object and comment as part of a chat session. This is clear from the portion cited by the Examiner, column 5, lines 1-15, as well as the remainder of Barrett. Similarly, Okada teaches a chat system wherein a message received from each client is immediately transmitted to all the other clients. See, e.g., column 4, lines 39-48. This is a conventional chat system which is well known. Indeed, what Okada does teach is presenting a message to a first user and accepting a reply to the message from the first user as part of a chat session. Thus, it is clear that because the electronic message in Okada as referred to in the rejection is not a media object or associated with a media object, it is simply an electronic message as part of a chat session. As stated in the claims, the limitations at issue are performed before the first and second users are connected in a messaging session.

Applicants, therefore, respectfully request withdrawal of the rejections of independent claims 1, 12 and 24 in view of Barrett and Okada for at least the above reasons, and of all claims depending therefrom based at least on their dependency therefrom

Applicants disagree with the contentions made in the Office Action that the dependent claims are taught or suggested by Barrett and Okada. However, given that the independent claims are believed to be patentably distinct over Barrett and Okada as discussed above, Applicants will reserve further argument regarding the dependent claims unless deemed necessary at a later time.

Claims 1-4, 7-14, 17-25, 27 and 28 were also rejected under 35 USC §103 as being unpatentable over Olivier *et al.*, US Patent No. 6,400,885 (hereinafter "Olivier") in view of Ng *et al.*, US Patent No. 6,424,647 (hereinafter "Ng"). This rejection is respectfully traversed for at least the following reasons.

Olivier discloses electronic mail systems and methods for exchanging group e-mails using user profiles and message criteria to distribute messages to recipient users based in part on the recipients' message criteria.

Ng discloses systems and methods for making a phone call connection over an Internet connection. Ng involves automatically dialing up a phone call connection across an Internet connection in response to a manually dialed telephone call connection. The parties to the original phone connection end that original connection and proceed to make a connection via the Internet.

Applicants respectfully assert that Olivier and Ng, either taken alone or in combination as suggested in the Office Action, neither teach nor suggest the limitations of the presently claimed invention. For example, Olivier does not teach the limitation of "providing the media object to be displayed to a second user along with the first comment" as is recited in the claim1 wherein the first comment was received from a first user and wherein the media object was displayed to a first user, e.g., to elicit the comment. Similar limitations are presented in independent claims 12 and 24. Olivier teaches distribution of e-mails to a group based on matching criteria defined in part by the recipients' profiles and the recipients' criteria stored in a database. The sections in Olivier pointed to by the Examiner, specifically column 6, lines 63-67

and column 19, lines 17-30, have nothing to do with providing a media object to a second user along with a comment from the first user. Rather, these sections teach the concept of an object ID for a database object that stores user profile information, not a media object, and the concept of combining two or more mailing lists into a single "meta-subscription" mailing list. Applicants fail to understand how these concepts even remotely relate to the claimed limitation of providing the media object to a second user along with the first comment (from the first user). Again, the present invention is directed to, and claims, providing a media object along with a comment to a second user, where the media object was initially provided to the first user and where the first user supplied the comment. The same media object is being displayed to the first and second users. When the second user view the media object, a comment received from the first user is provided therewith. Olivier does not teach or suggest this, nor does Ng, which teaches Internet phone call methods.

Notwithstanding the fact that Olivier and Ng do not teach or suggest limitations of the pending claims, a combination of these references as stated in the Office Action would not result in the presently claimed invention. The Examiner posits that it would be obvious to one skilled in the art to include Ng's automatic call connection features with Olivier to make up for Olivier not teaching the limitation of connecting the first and second users in an instant messaging session if the reply comment fits a matching criteria. Ng requires that the user initiate a first call manually; the differential dialing sequence of the Internet call then proceeds automatically. Additionally, the matching of source and destination locations discussed in Ng pertains to facilitating the differential dialing by adapting to different call dialing delays caused by the interconnection of different PSTN switches. See, e.g., column 15, lines 39 to 50. This has nothing whatsoever to do with a reply comment fitting a matching criteria. Thus, assuming one were to combine the references as stated, the combination would not teach the limitation of automatically connecting the users in a messaging session if the reply comment fits a matching criteria as is recited in the independent claims.

Applicants, therefore, respectfully request withdrawal of the rejections of independent claims 1, 12 and 24 in view of Olivier and Ng for at least the above reasons, and of all claims depending therefrom based at least on their dependency therefrom

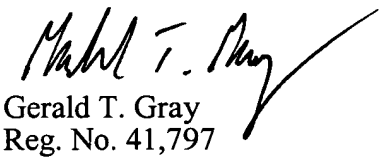
Applicants disagree with the contentions made in the Office Action that the dependent claims are taught or suggested by Olivier and Ng. However, given that the independent claims are believed to be patentably distinct over Olivier and Ng as discussed above, Applicants will reserve further argument regarding the dependent claims unless deemed necessary at a later time.

## CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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